



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,482	03/09/2004	Jeffery E. Maestas	TA-00685	2315

7590 03/10/2005

BRACEWELL & PATTERSON, L.L.P.  
P.O. BOX 61389  
HOUSTON, TX 77208-1389

EXAMINER

OKEZIE, ESTHER O

ART UNIT PAPER NUMBER

3654

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

154

**Office Action Summary**

**Application No.**

10/796,482

**Applicant(s)**

MAESTAS, JEFFERY E.

**Examiner**

Esther O. Okezie

**Art Unit**

3654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/09/2004</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boozer in view of O'Kane et al.
2. Regarding claim 1 Boozer discloses a magnetic pick up tool comprising:
  - a handle (12) having a first compartment (18) for supporting a battery (30), a second compartment (44) for supporting a voltage regulator circuit (circuit board 42, fig 4, column 4, lines 1-46), and a cover for concealing and providing access to only the first compartment (32);
  - a shaft (106) having a proximal end mounted to the handle and a distal end (figure 1);
  - a light (216) mounted to the distal end of the shaft and coupled to the battery for illuminating objects in remote locations (figure 11; column 4, lines 52-66);
  - an electromagnet mounted to the distal end of the shaft and coupled to the battery for attracting and retaining magnetic objects thereon (120, 202) ;
  - a switch (51) for allowing a user to direct the tool toward an object to be retrieved without the tool being attracted to surrounding magnetic components; and

Although Boozer shows a flexible elongate wand (302; 201) that is bendable and deformable and able to fit in remote places providing two additional degrees of freedom (figure 16), Boozer does not disclose a joint positioned in the shaft between a distal end of the shaft and the electromagnet for providing at least one additional degree of freedom of movement with respect to the shaft. O'Kane et al discloses an illuminated magnetic pickup tool wherein a light (30) is located concentrically within the electromagnet, both are connected to a battery 18, and a ball joint (38) is interposed between the distal end of the shaft and the electromagnet (fig. 5). It would have been obvious to one of ordinary skill in the art to modify the shaft of Boozer to include a ball joint as taught by O'Kane in order to provide a more stable adjustment feature for bending the shaft to reach remote places.

3. Regarding claim 2 Boozer discloses the tool of claim 1 wherein a fiber optic member (250) connected to a light bulb (216). This fiber optic member transmits light through the distal end of the electromagnet and is located concentrically within the tubular electromagnet (202, see figure 11).

4. Regarding claims 3 and 4 Boozer discloses the tool of claim 1 wherein the handle contains rechargeable batteries (30) and couples to a charging stand to recharge the rechargeable batteries (column 4, lines 45-52).

5. Regarding claim 5 Boozer discloses a flexible, bendable shaft (106) but does not disclose this shaft as telescopic. O'Kane discloses a telescopic shaft (fig 4). It would

have been obvious to one of ordinary skill in the art to modify the shaft of Boozer to be telescopic in order to extend or shorten the reach of the tool effectively.

6. Regarding claim 6 Boozer shows a flexible elongate wand (302; 201) that is bendable and deformable and able to fit in remote places providing two additional degrees of freedom (figure 16). Boozer does not disclose a joint positioned in the shaft between a distal end of the shaft and the electromagnet for providing at least one additional degree of freedom of movement with respect to the shaft. O'Kane et al discloses an illuminated magnetic pickup tool wherein a light (30) is located concentrically within the electromagnet, both are connected to a battery 18, and a ball joint (38) is interposed between the distal end of the shaft and the electromagnet (fig. 5). It would have been obvious to one of ordinary skill in the art to modify the shaft of Boozer to include a ball joint as taught by O'Kane in order to provide a more stable adjustment feature for bending the shaft to reach remote places.

7. Regarding claim 7 Boozer discloses the tool of claim 1 wherein the shaft is hollow and contains sliding and wiping electrical contacts (108 and 110) to provide power to the light and the electromagnet in both the collapsed and extended positions (column 5, lines 25-39; Also see figure 6).

8. Regarding claim 8 Boozer discloses the tool of claim 1 wherein the switch is a momentary, double-throw switch (58, column 4, lines 1-14, lines 53-61).

9. Regarding claim 9 Boozer discloses the tool of claim 1 wherein the switch has a first position wherein both the light and the electromagnet are off, a second position

Art Unit: 3654

wherein only the light is on, and a third position wherein both the light and the electromagnet are on (switch 58, column 4, lines 1-14, lines 53-61).

10. Regarding claim 10 Boozer discloses the tool of claim 1 wherein the switch has a locking feature to alleviate a need for constant user engagement of the switch in each of the positions (column 4, lines 1-14, lines 53-61).

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boozer in view of O'Kane as applied to claims 1-10 above, and further in view of Kaderabek. The combination of Boozer and O'Kane does not show an additional magnet mounted to the handle and adapted to allow the pick-up tool to magnetically adhere to and be retained on a magnetic object. Kaderabek discloses an electric soldering iron tool with a magnetic plate (37) in the handle for mounting the tool on a metal surface. It would have been obvious to one of ordinary skill in the art to provide a magnet for mounting a tool to a surface as taught by Kaderabek in order to easily support the tool when not in use.

12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boozer in view of O'Kane as applied to claims 1-10 above, and further in view of Shiao. The combination of Boozer and O'Kane does not specifically mention the light as selected from a group consisting of incandescent and light emitting diode (LED) lights. Although Boozer mentions the use of LED lights within the voltage regulating circuit (figure 4), Boozer does not specifically mention LED lights for the light at the distal end of the shaft near the magnet. Shiao shows a telescopic magnetic retriever with a light (50) that is

specifically referenced as an LED (column 3, lines 27-30). It would have been obvious to one of ordinary skill in the art to modify the light of Boozer to include an LED light as taught by Shiao.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boozer in view of O'Kane as applied to claims 1-10 above, and further in view of Kaderabek. Boozer discloses a handle (12) having a first compartment (18) for supporting a battery (30), a second compartment (44) for supporting a voltage regulator circuit (circuit board 42, fig 4, column 4, lines 1-46), and a cover for concealing and providing access to only the first compartment (32);

a shaft (106) having a proximal end mounted to the handle and a distal end (figure 1);

a light (216) mounted to the distal end of the shaft and coupled to the battery for illuminating objects in remote locations (figure 11; column 4, lines 52-66);

an electromagnet mounted to the distal end of the shaft and coupled to the battery for attracting and retaining magnetic objects thereon (120, 202) ;

a switch (51) for allowing a user to direct the tool toward an object to be retrieved without the tool being attracted to surrounding magnetic components, the switch has a first position wherein both the light and the electromagnet are off, a second position wherein only the light is on, and a third position wherein both the light and the electromagnet are on (switch 58, column 4, lines 1-14, lines 53-61).

Although Boozer shows a flexible elongate wand (302; 201) that is bendable and deformable and able to fit in remote places providing two additional degrees of freedom (figure 16). Boozer does not disclose a joint positioned in the shaft between a distal end of the shaft and the electromagnet for providing at least one additional degree of freedom of movement with respect to the shaft. O'Kane et al discloses an illuminated magnetic pickup tool wherein a light (30) is located concentrically within the electromagnet, both are connected to a battery 18, and a ball joint (38) is interposed between the distal end of the shaft and the electromagnet (fig. 5). It would have been obvious to one of ordinary skill in the art to modify the shaft of Boozer to include a ball joint as taught by O'Kane in order to provide a more stable adjustment feature for bending the shaft to reach remote places.

Furthermore, Boozer discloses a flexible, bendable shaft (106) but does not disclose this shaft as telescopic. O'Kane discloses a telescopic shaft (fig 4). It would have been obvious to one of ordinary skill in the art to modify the shaft of Boozer to be telescopic in order to extend or shorten the reach of the tool effectively.

Lastly, Boozer does not show an additional magnet mounted to the handle and adapted to allow the pick-up tool to magnetically adhere to and be retained on a magnetic object. Kaderabek discloses an electric soldering iron tool with a magnetic plate (37) in the handle for mounting the tool on a metal surface. It would have been obvious to one of ordinary skill in the art to provide a magnet for mounting a tool to a surface as taught by Kaderabek in order to easily support the tool when not in use.



Art Unit: 3654

13. Regarding claim 14 Boozer discloses the tool of claim 13 wherein a fiber optic member (250) connected to a light bulb (216). This fiber optic member transmits light through the distal end of the electromagnet and is located concentrically within the tubular electromagnet (202, see figure 11).

14. Regarding claims 15 and 16 Boozer discloses the tool of claim 13 wherein the handle contains rechargeable batteries (30) and couples to a charging stand to recharge the rechargeable batteries (column 4, lines 45-52).

15. Regarding claim 17 Boozer shows a flexible elongate wand (302; 201) that is bendable and deformable and able to fit in remote places providing two additional degrees of freedom (figure 16). Boozer does not disclose a joint positioned in the shaft between a distal end of the shaft and the electromagnet for providing at least one additional degree of freedom of movement with respect to the shaft. O'Kane et al discloses an illuminated magnetic pickup tool wherein a light (30) is located concentrically within the electromagnet, both are connected to a battery 18, and a ball joint (38) is interposed between the distal end of the shaft and the electromagnet (fig. 5). It would have been obvious to one of ordinary skill in the art to modify the shaft of Boozer to include a ball joint as taught by O'Kane in order to provide a more stable adjustment feature for bending the shaft to reach remote places.

16. Regarding claim 18 Boozer discloses the tool of claim 13 wherein the switch is a momentary, double-throw switch (58, column 4, lines 1-14, lines 53-61).

17. Regarding claim 19 Boozer discloses the tool of claim 13 wherein the shaft is hollow and contains sliding and wiping electrical contacts (108 and 110) to provide

Art Unit: 3654

power to the light and the electromagnet in both the collapsed and extended positions (column 5, lines 25-39; Also see figure 6).

18. Regarding claim 20 Boozer discloses the tool of claim 19 wherein the switch has a locking feature to alleviate a need for constant user engagement of the switch in each of the positions (column 4, lines 1-14, lines 53-61).

19. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boozer in view of O'Kane and Kaderabek as applied to claims 13-20 above, and further in view of Shiao. The combination of Boozer and O'Kane does not specifically mention the light as selected from a group consisting of incandescent and light emitting diode (LED) lights. Although Boozer mentions the use of LED lights within the voltage regulating circuit (figure 4), Boozer does not specifically mention LED lights for the light at the distal end of the shaft near the magnet. Shiao shows a telescopic magnetic retriever with a light (50) that is specifically referenced as an LED (column 3, lines 27-30). It would have been obvious to one of ordinary skill in the art to modify the light of Boozer to include an LED light as taught by Shiao.

### ***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US-5704,674; US-D276,690; US-3,582,123; US-6,312,138.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Esther O. Okezie whose telephone number is (703) 305-0433. The examiner can normally be reached on Mon-Fri 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine A Matecki can be reached on (703) 308-2688. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

eoo

  
KATHY MATECKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

Application/Control Number: 10/796,482

Page 11

Art Unit: 3654